

S.N. 10/027,744  
Art Unit 3721  
Atty Dkt PP 5.71(c)

REMARKS

Claims 20-94 were pending in the application prior to this amendment. Claim 21 has been amended herein. Claims 20 and 22-94 remain in the application unchanged. Accordingly, after entry of this amendment, claims 20-94 will remain pending in the application. Reexamination and reconsideration are requested.

I. **Rejection of Claims 21-26 Under 35 U.S.C. 112, Second Paragraph**

Claims 21-26 stand rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Reexamination and reconsideration of the Examiner's rejection are requested.

The Examiner indicates that the language of claim 21 is not clear. Applicant has amended claim 21 herein to remove the word "further" before "comprising". It is believed that this amendment improves the clarity of the claim. Claim 21, as amended, reads as follows:

The process of claim 20 wherein:

said pour spout means front panel comprises a lamination of a paperboard material and a plastic material.

Claim 21, thus, recites that the front panel of the pour spout means comprises a lamination of a paperboard material and a plastic material. This arrangement is clearly disclosed in the present application with reference, for example, to drawing Fig. 15 and to the written specification where the following is set forth:

As illustrated in Fig. 15, the pour spout 194 is formed from a **lamination** of a conventional **paperboard** 262, preferably formed from bleached Kraft fibers and having a thickness of about 0.015 inch laminated by a suitable adhesive to a film 264 of a **polyester material** having a thickness of about 0.0005 inch and the exposed surface thereof is coated with a coating layer 266 of a **polyethylene material** or a material having similar characteristics.

(page 15, lines 25-31, emphasis added)

Accordingly, the pour spout 194 is clearly disclosed as comprising a lamination of paperboard material and a plastic material. Thus, the front

S.N. 10/027,744  
Art Unit 3721  
Atty Dkt PP 5.71(c)

panel of the pour spout is also disclosed, for example, as comprising a lamination of a paperboard material and a plastic material as recited in claim 21.

For the reasons set forth above, the Examiner's rejection is believed to be addressed.

## **II. Legal Basis for Prior Art Claim Rejections Made in the Office Action**

### Legal Basis for Claim Rejection Under 35 U.S.C. §102

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. 102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986).

### Legal Basis for Obviousness under 35 U.S.C. §103

The test for obviousness under 35 U.S.C. 103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the reference or references. *In re Donovan*, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. *In re Rinehart*, 189 USPQ 143, 146 (CCPA 1976). All limitations of the Claims must be considered. *In re Boe*, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of applicant's teachings. *In re Meng*, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a Section 103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. *In re Lintner*, 173 USPQ 560, 562 (CCPA 1972).

A basic mandate inherent in Section 103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of

what such reference fairly suggests to one of ordinary skill in the art. *In re Kamm*, 172 USPQ 298, 301-302 (CCPA 1972). Phrased somewhat differently, the fact that inventions of the references and of applicant may be directed to concepts for solving the same problem does not serve as a basis for arbitrarily choosing elements from references to attempt to fashion applicant's claimed invention. *In re Donovan*, 184 USPQ 414, 420 (CCPA 1975).

It is also clearly established in the case law that a change in the mode of operation of a device which renders that device inoperative for its stated utility as set forth in the cited reference renders the reference improper for use to support an obviousness-type rejection predicated on such a change. See, e.g. *Diamond International Corp. v. Walterhoefer*, 289 F.Supp. 550, 159 USPQ 452, 460-61 (D.Md. 1968); *Ex parte Weber*, 154 USPQ 491, 492 (Bd.App. 1967). In addition, any attempt to combine the teaching of one reference with that of another in such a manner as to render the invention of the first reference inoperative is not permissible. See, e.g., *Ex parte Hartmann*, 186 USPQ 366 (Bd.App. 1974); and *Ex parte Sternau*, 155 USPQ 733 (Bd.App. 1967).

In the case of *In re Wright*, 6 USPQ 2d 1959 (CAFC 1988), the CAFC decided that the Patent Office had improperly combined references which did not suggest the properties and results of the applicant's invention nor suggest the claimed combination as a solution to the problem which applicant's invention solved.

The CCPA reached this conclusion after an analysis of the prior case law, at p. 1961:

We repeat the mandate of 35 U.S.C. 103: it is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves. See, e.g., *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985) ("In evaluating obviousness, the hypothetical person of ordinary skill in the

pertinent art is presumed to have the 'ability to select and utilize knowledge from other arts reasonably pertinent to [the] particular problem' to which the invention is directed"), quoting *In re Antle*, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971); *In re Antonie*, 559 F.2d 618, 619, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the Specification") (emphasis in original).

The determination of whether a novel structure is or is not "obvious" requires cognizance of the properties of that structure and the problem which it solves, viewed in light of the teachings of the prior art. See, e.g., *In re Rinehart*, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (the particular problem facing the inventor must be considered in determining obviousness); see also *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984) (it is error to focus "solely on the product created, rather than on the obviousness or notoriousness of its creation") (quoting *General Motors Corp. v. U.S. Int'l Trade Comm'n*, 687 F.2d 476, 483, 215 USPQ 484, 489 (CCPA 1982), cert. denied, 459 U.S. 1105 (1983)).

Thus the question is whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working. *Rinehart*, 531 F.2d at 1054, 189 USPQ at 149; see also *In re Benno*, 768 F.2d 1340, 1345, 226 USPQ 683, 687 (Fed. Cir. 1985) ("appellant's problem" and the prior art present different problems requiring different solutions").

A reference which teaches away from the applicant's invention may not properly be used in framing a 35 U.S.C. 103 rejection of applicant's claims. See *United States v. Adams*, 148 USPQ 429 (Sup. Ct. 1966).

**III. Rejection of Claim 20 under 35 U.S.C. §102(b)**

Claim 20 stands rejected under 35 U.S.C. §102(b) as being anticipated by Nerenberg et al. (U.S. 2,820,585). Reexamination and reconsideration of the Examiner's rejection are requested.

Applicant's claim 20 recites the following:

Process for making a dispensing assembly comprising:

(a) providing carton means having a dispensing opening in a side wall thereof, pour spout means mounted in said dispensing opening and including a front panel and separate liner means in said carton;

(b) bonding said liner means to said front panel whereby upon initial opening of the pour spout means, that portion of the liner bonded to said front panel separates from said liner means providing access to the interior thereof.

Applicant respectfully asserts that the Examiner's rejection is improper for at least the following independent reasons:

- 1. The Examiner should give full faith and credit to prior determinations by the U.S. Patent and Trademark Office; and**
- 2. Claim 20 is not, in fact, anticipated by Nerenberg et al.**

The above reasons are discussed in detail below.

**1. The Examiner should give full faith and credit to prior determinations by the U.S. Patent and Trademark Office**

As noted, for example, in applicant's preliminary amendment filed concurrently with the application on December 20, 2001, applicant's claim 20 is identical to claim 11 of issued U.S. Patent No. 6,145,736 (hereinafter the '736 Patent). Further, the Nerenberg et al. reference applied by the Examiner in the rejection of applicant's claim 20 is of record in the '736 Patent.

Accordingly, the U.S. Patent and Trademark Office considered the Nerenberg et al. reference when reaching a decision to allow claim 11 during prosecution of the '736 Patent.

The current Examiner, thus, is rejecting a claim that was previously allowed by an Examiner in the U.S. Patent and Trademark Office. Furthermore, the current Examiner is basing this rejection on a reference that was considered by the previous Examiner.

MPEP §706.04 sets forth, for example, the following:

Great care should be exercised in authorizing [a rejection of a claim previously noted as being allowable].

...

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art.

This section of the MPEP, thus, stresses that full faith and credit should be given to the action of a previous Examiner unless:

- a. there is a clear error in the previous action; or
- b. there is knowledge of other prior art.



With respect to alternative b., there is clearly no issue relative to "knowledge of other prior art" in the present case. As noted above, the Nerenberg et al. reference (the only reference applied to reject applicant's claim 20) was considered by the previous Examiner during prosecution of the '736 Patent. Accordingly, in the current case, there is no issue concerning "knowledge of other prior art".

The present Examiner, thus, is apparently taking the position that the previous Examiner committed "**clear error**" in allowing claim 11 in the '736 Patent. Applicant disagrees with this position. As discussed below, applicant asserts that Nerenberg et al. does not disclose a "pour spout" as recited in claim 20 and that, therefore, claim 20 is not anticipated by Nerenberg et al. The previous Examiner in the '736 Patent apparently agreed with this position since, as discussed above, the previous Examiner allowed claim 11 in the '736 Patent (a claim identical to applicant's current claim 20) over the Nerenberg et al. reference. The present Examiner has supplied absolutely no reasoning or argument whatsoever as to why it is believed that the previous Examiner's position constitutes "clear error" in this regard.

Although MPEP §706.04 generally deals with the rejection of a previously allowed claim in the *same application*, this section, nevertheless, emphasizes the importance of giving full faith and credit, absent clear error, to prior determinations by U.S. Patent and Trademark Office patent examiners.

MPEP §2307.02 addresses the specific situation in which a claim copied from a patent is rejected on grounds which would also be applicable to the corresponding claim(s) in the patent. Although this practice is not specifically prohibited by §2307.02, this section of the MPEP, nevertheless, emphasizes the serious nature of rejecting a claim in this manner (e.g., by requiring approval of a Group Director when such a rejection is to be made).

Such emphasis is not surprising since, by raising such a rejection, an examiner is clearly calling into question the validity of an issued U.S. patent claim.

Applicant respectfully requests that, if the current rejection is to be maintained, then the Examiner explain in detail in what way the previous Examiner (in the '736 Patent) is believed to have committed "clear error".

**2. Claim 20 is not, in fact, anticipated by Nerenberg et al.**

The Examiner takes the position that Nerenberg et al. anticipates claim 20 and states the following in support of this position on page 3 of the Office action:

Nerenberg discloses a process for making a dispensing assembly comprising the steps of providing carton means (1) having a dispensing opening (U shape 4) in a side wall (2) thereof, pour spout means (6) mounted in the dispensing opening and including a front panel and separate liner means in the carton (liner 10); bonding the liner means to the front panel whereby upon initial opening of the pour spout means a portion of the liner bonded to the front panel separates from the liner means providing access to the interior thereof, see for example (Figs. 3, 5, and 7).

The Examiner, thus, apparently takes the position that the tab 6 of Nerenberg et al. is a "pour spout means" as recited in applicant's claim 20. Applicant respectfully disagrees with this position for the following reasons.

Referring, for example, to Fig. 3 of Nerenberg et al., the tab 6 is attached to a flap area 5. To initially open the Nerenberg et al. carton, the flap area 5 is first pushed inwardly, as shown in Figs. 3 and 4, causing the flap area 5 to pivot about a fold line formed between the flap area 5 and the carton body wall 2. The tab 6 is then used to pull the flap area 5 out of the carton as shown in Figs. 5 and 6, again by pivoting the flap area about the

fold line. Finally, the flap area 5 is secured in the open position by inserting the tab 6 between the top closure 3 and the liner 10 as shown in Fig. 7. See Nerenberg et al. at column 3, lines 14-52 where the opening operation is discussed.

Applicant respectfully asserts that neither the tab 6 nor the flap area 5 of Nerenberg et al. can reasonably be considered to be a "pour spout" as recited in claim 20.

It is noted that the dictionary (Webster's Collegiate, Tenth Edition, 1994) defines the noun "spout" as follows:

1 : a pipe or conductor through which a liquid is discharged or conveyed in a stream: as a : a pipe for carrying rainwater from a roof b : a projecting tube or lip from which a liquid (as water) issues 2 : a discharge or jet of liquid from or as if from a pipe; esp : WATERSPOUT 3 *archaic* : PAWNSHOP

Of the three definitions provided by Webster's, definitions 2 and 3 are obviously irrelevant to the current inquiry since definition 2 relates to the liquid itself and definition 3 refers to a the archaic use of the term to denote a pawnshop. With respect to definition 1, "a pipe or conductor through which a liquid is discharged or conveyed in a stream" connotes a structure that contacts a liquid being conveyed and that is capable of exercising control over the movement of the liquid. Sub-definitions a : and b : continue this theme: in a :, "a pipe for carrying rainwater from a roof" suggests that the pipe both contacts the liquid and directs its flow; in b :, a tube or lip "from which a liquid ... issues" also suggests both contact with the liquid and control of its movement.

Based on the above, it is clear that any reasonable interpretation of the noun "spout" would include a structure that both contacts a liquid being conveyed and controls the movement of the liquid. The use of the term "spout" in applicant's disclosure is consistent with this interpretation (although

applicant's dispensing assembly is not specifically disclosed as being used with liquids, it is clearly useable in conjunction with flowable food products, such as cereals, that act in a more or less liquid-like manner when being poured or dispensed). Referring, for example, to applicant's drawing Figs. 6-9, it can be appreciated that the spout forming piece 122 is disclosed as including a central portion 124 and two attached wing portions 126 and 128 (see, also, e.g., applicant's written description at page 12, lines 3-4). With reference, for example, to Fig. 9, it can be appreciated that, when the spout is moved to its open position, the central portion 124 and wing portion 126, 128 together are capable of contacting, guiding and directing the product being dispensed from the carton opening.

Turning now to the current rejection, contrary to the Examiner's assertion, the tab 6 of Nerenberg et al. is not a "pour spout" given any reasonable definition of the term as discussed above. More specifically, the Nerenberg et al. tab 6 is not capable of contacting product being dispensed from the carton. With reference to Figs. 5 and 7 of Nerenberg et al., it can be seen that a flap area 5 is, at all times, located between the dispensing opening in the carton and the tab 6. Accordingly, it is not possible for the tab 6 to contact the product being dispensed from the Nerenberg et al. carton, much less control the movement of the product as it is dispensed. The Nerenberg et al. tab 6, thus, is not a "pour spout" as recited in applicant's claim 20.

It is further noted that the Nerenberg et al. flap area 5, although adjacent the dispensing opening, also cannot be considered to be a "pour spout" as recited in claim 20. With reference, for example, to Fig. 7 of Nerenberg et al., it can be appreciated that the flap area 5 is moved to an open position prior to dispensing product from the carton. In fact, as further shown in Fig. 7, the flap area 5 is held in this open position by inserting the free end of the tab 6 into a slot 13 formed in the carton (see, e.g., Nerenberg

et al., col. 3, lines 44-52 where this is discussed). In this manner, the flap area 6 is held away from the carton dispensing opening (as illustrated in Fig. 7) such that the flap area will not contact product being dispensed from the carton. Accordingly, even when the Nerenberg et al. carton is tipped up in order to dispense product through the dispensing opening, the product will not contact the flap area 6. Further, the movement of the product out of the carton will clearly not be "controlled" by the flap area 6. The flap area 6 of Nerenberg et al., thus, also cannot be considered to be a "pour spout" since any reasonable interpretation of this term, as discussed above, requires a structure that both contacts and controls the movement of the a flowable product being conveyed.

Since Nerenberg et al. does not disclose a pour spout as recited in claim 20, Nerenberg et al. does not anticipate claim 20. As previously noted, the standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. 102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986).

In summary, applicant asserts that claim 20 is not anticipated by Nerenberg et al. Further, no explanation or reasoning has been provided in support of the present Examiner's apparent position that the previous Examiner (in the '736 Patent) committed "clear error" in allowing the same claim over the Nerenberg et al. reference.

**IV. Rejection of claims 21, 22, 24, 27 and 28 Under 35 U.S.C. §103(a)**

Claims 21, 22, 24, 27 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nerenberg et al. (U.S. 2,820,585) in view of Sternau (U.S. 3,605,578). Reexamination and reconsideration of the Examiner's rejection are requested.

At the outset, applicant notes that the Examiner's rejection of dependent claim 24 appears to be improper. Specifically, the Examiner rejects claim 24 over Nerenberg et al. in view of Sternau. Claim 24, however, depends from claim 23. Claim 23 does not stand rejected over Nerenberg et al. and Sternau, but rather over Nerenberg et al. in view of Sternau *and Knauf* (see page 5 of the Office action). It is not understood how claim 24 can be rejected over Nerenberg et al. and Sternau when claim 23 (from which claim 24 depends) is rejected over Nerenberg et al., Sternau and Knauf. Clarification is requested.

Claims 21, 22, 24, 27 and 28 are allowable at least as depending from allowable base claim 20. Claims 21, 22, 24, 27 and 28 are allowable on further independent grounds in that there is no motivation to combine the references as proposed by the Examiner. To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the combination. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). *Also, see In re Raynes*, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

In the present case, there is no teaching, suggestion or motivation in

either Nerenberg et al. or Sternau to combine the references as proposed by the Examiner. The only possible motivation to combine the references arises from the teachings in applicant's own application. Reliance upon applicant's own teachings in this manner, however, is not permissible since obviousness cannot be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). As discussed in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

Claim 21 is allowable on further independent grounds in that neither Nerenberg et al., Sternau nor any of the other references of record, considered either alone or in proper combination, disclose or suggest the process of claim 20 and further wherein:

said pour spout means front panel comprises a lamination of a paperboard material and a plastic material.

The Examiner states the following on pages 3-4 of the Office action:

Nerenberg does not disclose that "the pour spout means front panel further comprises a lamination of a paperboard material and a plastic material". However, Sternau discloses a similar method for making a dispensing assembly comprising the pour spout means front panel comprises a lamination of a paperboard material and a plastic material (column 2, lines 35 and 36) ....

The Examiner, thus, admits that Nerenberg et al. does not disclose a lamination as recited in claim 21 but takes the position that Sternau does teach such a lamination and that it would be obvious to apply this teaching to

the Nerenberg et al. container. Applicant respectfully disagrees with this position and asserts that Sternau does not, in fact, disclose a lamination as recited in claim 21. The Examiner points to column 2, lines 35-36 of Sternau in support of the position discussed above. This portion of Sternau is reproduced as follows:

In Figs. 1, 2 and 3, a rectangular cardboard box or carton 10, containing material to be poured, integrally

The portion of Sternau cited by the Examiner clearly does not mention a "lamination" as recited in claim 21. Sternau further sets forth the following:

The channel 22 may be made from cardboard, metal, paper or plastic ...

(col. 2, lines 43-44)

Sternau, thus, specifically teaches that the channel 22 may be formed from cardboard, metal, paper *or* plastic. Sternau does not, however, suggest that a lamination of two or more materials can be used. Accordingly, even the (improper - as discussed above) combination of references proposed by the Examiner fails to produce all of the elements of applicant's claim 21.

Claim 22 is allowable on further independent grounds in that neither Nerenberg et al., Sternau nor any of the other references of record, considered either alone or in proper combination, disclose or suggest the process of claims 20 and 21 and further wherein:

said plastic material comprises a polyester material.

The Examiner states the following on page 4 of the Office action:



Regarding claim 22: Nerenberg nor Sternau disclose the plastic material comprises a polyester material. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Nernberg's [sic] method by having the plastic material comprises a polyester material, as a matter of engineering design choice, since the examiner takes an official notice that the mentioned plastic material comprises a polyester material, is old, well known, and available in the art.

The Examiner's statement is not understood. More specifically, it is not clear whether the Examiner is taking official notice that polyester is a well-known plastic or that it is well known to use polyester in a lamination that is used to form a pour spout. If the former, then applicant agrees that polyester is a generally well-known material, but asserts that its use in a manner as recited in claim 22 (e.g., as part of a laminate used to form a pour spout) is ***not well-known***. If the latter, then applicant completely disagrees with the Examiner and hereby traverses the Examiner's finding. As mentioned above, it is clearly not well known to use polyester as part of a laminate to form a pour spout as recited in claim 22.

Claim 24 is allowable on further independent grounds in that neither Nerenberg et al., Sternau nor any of the other references of record, considered either alone or in proper combination, disclose or suggest the process of claims 20, 21 and 23 and further wherein:

said coating layer comprises polyethylene.

Sternau does not disclose a coating layer; accordingly, Sternau necessarily does not disclose or suggest a coating layer comprising polyethylene as recited in claim 24.

Claims 27 and 28 are allowable on further independent grounds in that

neither Nerenberg et al., Sternau nor any of the other references of record, considered either alone or in proper combination, disclose or suggest the process of claim 20 and further wherein:

said pour spout means further comprises:

a first wing portion; and

a second wing portion.

(claim 27)

or

said first wing portion is attached to said front panel at a first fold line and said second wing portion is attached to said front panel at a second fold line.

(claim 28)

On page 4 of the Office action, the Examiner proposes to combine Nerenberg et al. and Sternau to render applicant's invention obvious. In explaining this rejection, the Examiner states the following on page 4 of the Office action:

Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to have modified Nerenberg's method by having the pour spout means front panel further comprise a lamination of paperboard material and a plastic material wherein the coating layer comprises polyethylene and the pour spout comprises a first wing portion and a second wing portion ....

The Examiner, thus, takes the position that it would be obvious, in view of Sternau, to provide the Nerenberg et al. tab 6 in the form of a pour spout

having first and second wing portions. Applicant respectfully asserts that the Examiner's position is improper because modifying Nerenberg et al., as proposed by the Examiner would result in an inoperative device. As previously noted, any attempt to combine the teaching of one reference with that of another in such a manner as to render the invention of the first reference inoperative is not permissible. See, e.g., *Ex parte Hartmann*, 186 USPQ 366 (Bd.App. 1974); and *Ex parte Sternau*, 155 USPQ 733 (Bd.App. 1967).

Referring, first, to Nerenberg et al., a carton 1 is disclosed having a flap area 5 defined by a U-shaped cutout 4. A liner 10 is provided on the interior of the carton 1. To open the carton 1, inwardly directed pressure is applied to the flap area 5 (see Figs. 3 and 4). The inward movement of the flap area 5 causes the liner to tear along a line following the curvature of the U-shaped cutout 4. Thereafter, the tab 6 may be used to pull the flap area outwardly to the open position shown in Figs. 5-7.

Sternau discloses, with reference to Fig. 4, a flap 12 defined by a series of perforations 40 (Fig. 5) formed in the sideface 16 (Figs. 2 and 3) of a carton 10. A separate "chute shaped channel" 22 includes a center section 20 and integrally formed wings 24 and 26 (see, e.g., Fig. 5). The wings 24, 26 are joined to the center section 20 via a pair of weakened lines 42, forming fold lines (see Sternau, col. 3, lines 7-8).

The center section 20 of the channel 22 is glued to the interior face of the flap 12 (see Sternau, col. 2, lines 40-43). To open the carton 10, the flap 12 is first pressed inwardly in order to break the perforations 40. Thereafter, the tab 38, is used to pull the flap outwardly to the open position illustrated in Figs. 1 and 2 (see Sternau, column 3, lines 11-19).

Fig. 5 of Sternau illustrates the carton 10 before it is initially opened. In this condition, the wings 24, 26 of the channel 22 are coplanar with the center section 20 and, thus, lie against the interior surface of the sideface 16. The

Sternau reference discloses this arrangement, for example, as follows:

Figs. 4 and 5 show the box 10 before it is opened. Perforations 40 extend partly through the sideface 16 along the arch that defines the flap 12. For simplicity in assembly the channel 11 [sic - 22] appears unfolded flat against the interior of the sideface 16 in butterfly fashion.

(Sternau, col. 3, lines 3-7)

Accordingly, in the unopened condition shown in Fig. 5, the wings 24, 26 have not yet been folded about the weakened lines 42.

As described above, when the Sternau carton 10 is initially opened, the flap 12 (and the attached channel center section 20) is moved outwardly. This outward movement, in turn, causes the channel wings 24, 26 to contact the edges of the opening 18 and fold about the weakened lines 42 until the wings assume a right-angle relationship with respect to the channel center section 20 and the sideface 16. This is described in Sternau, for example, as follows:

The user now grasps the inwardly leaning flap, which carries the chute-shaped channel, by means of the tab 38 and pulls the flap and spout assembly outward into the desired position. During this outward movement the flat-lying wings 24 and 26 shown in FIG. 5 as they are drawn outwardly against the vertical edges of opening 18 fold along the weakened lines 42 into the shape in FIG. 1.

(col. 3, lines 16-23)

The Examiner takes the position that it would be obvious to modify Nerenberg et al. by providing the Nerenberg et al. container with a "chute-shaped channel" of the type taught by Sternau.

Applicant points out, however, that Nerenberg et al. stresses the importance of adhering the liner 10 to the outer layer of the carton

*immediately adjacent the opening.* Nerenberg et al. discusses this importance, for example, as follows:

It is important, however, in the association of the liner with the carton that the liner be adhered to the carton wall in the area of the U-shaped cut 4 defining the flap area 5; and we have found that the liner should be drawn as taut as possible across the adhered area.... By drawing the liner taut cross the flap area 5, a kind of drumhead effect is obtained, so that sharp inward pressure along the U-shaped cut will automatically break the liner simultaneously with the formation of the pouring opening in the carton body wall.

(col. 2, line 68 - col. 3, line 10)

Nerenberg et al., thus, stresses the criticality of drawing the liner taut across the opening in order to achieve proper operation of the carton. Nerenberg et al. further teaches that this tautness is to be achieved by adhering the liner to the carton wall in the immediate vicinity of the opening.

Applicant asserts that, in the combination of Nerenberg et al. and Sternau proposed by the Examiner, the liner could not be adhered to the carton wall in the immediate vicinity of the opening and that, as a result, the requisite tautness could not be achieved. Referring, for example, to Fig. 5 of Sternau, it can be appreciated that the presence of the wings 24, 26 would prevent a liner from being adhered to the carton sideface 16 immediately adjacent the opening 18. Accordingly, the tautness stressed by Nerenberg et al. as being critical to proper operation could not be achieved in the combination proposed by the Examiner. Accordingly, the Examiner's proposed combination of Sternau and Nerenberg et al. would result in an inoperative device.

Applicant further respectfully asserts that the Examiner's proposed modification of Nerenberg et al. would result in an inoperative device for an

additional reason as will now be discussed. As noted above, before the Sternau carton is initially opened, the channel wings 24, 26 are parallel to the carton sideface 16, as shown in Fig. 5. When the carton is opened, however, the wings 24, 26 rotate up and away from the sideface until they are perpendicular to the sideface (as shown in Figs. 1-3).

The Examiner suggests that it would be obvious to modify Nerenberg et al. by providing the Nerenberg et al. container with a "chute-shaped channel" of the type taught by Sternau. Applicant asserts that, even if the opening could be formed in such a modified structure (and it could not as pointed out above), the existence of the liner would prevent the wings 24, 26 from being able to rotate as required for proper opening.

For the reasons set forth above, the Examiner's proposed combination of Nerenberg et al. and Sternau would result in an inoperative device. Accordingly, applicant respectfully asserts that the Examiner's rejection of claims 27 and 28 is improper:

If when combined, the references "would produce a seemingly inoperative device," then they teach away from their combination. *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969); *see also In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

*Tec Air Inc. v. Denso Manufacturing Michigan Inc.*, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999)

... it is generally settled that the change in prior art device which makes the device inoperable for its intended purpose cannot be considered to be an obvious change. *Hughes Aircraft Co v. United States*, 215 U.S.P.Q. 787, 804 (Ct.Cl. Trial Div. 1982) modified (to affirm validity and reverse infringement holding), 717 F.2d 1351, 219 USPQ 473 (Fed. Cir. 1983).

S.N. 10/027,744  
Art Unit 3721  
Atty Dkt PP 5.71(c)

As quoted in *Bausch & Lomb Inc. v. Barnes-Hind/Hydrocurve Inc.*, 10  
USPQ2d 1929 (DC N.Cal. 1989).

**V. Rejection of claims 23, 25 and 26 Under 35 U.S.C. §103(a)**

Claims 23, 25 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nerenberg et al. (U.S. 2,820,585) in view of Sternau (U.S. 3,605,578) and further in view of Knauf (U.S. 5,415,910). Reexamination and reconsideration of the Examiner's rejection are requested.

Claims 23, 25 and 26 are allowable at least as ultimately depending from allowable base claim 20. Claims 23, 25 and 26 are allowable on further independent grounds in that there is no motivation to combine the references as proposed by the Examiner. To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the combination. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). Also, see *In re Raynes*, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

In the present case, there is no teaching, suggestion or motivation in either Nerenberg et al., Sternau or Knauf to combine the references as proposed by the Examiner. The only possible motivation to combine the references arises from the teachings in applicant's own application. Reliance upon applicant's own teachings in this manner, however, is not permissible since obviousness cannot be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). As discussed in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.



Claims 23, 25 and 26 are allowable on further independent grounds in that neither Nerenberg et al., Sternau, Knauf nor any of the other references of record, considered either alone or in proper combination, disclose or suggest the process of claim 20 and further:

comprising a coating layer on said plastic material  
(claim 23)

or

wherein said bonding said liner means to said front panel comprises  
bonding said liner means to said coating layer  
(claim 25)

or

further comprising forming at least one cut line in said coating layer  
(claim 26)

The Examiner states the following on page 5 of the Office action:

Nerenberg nor Nerenberg [sic] disclose the step of bonding the liner means to the front panel comprises bonding the liner means to the coating layer nor forming at least one cut line in the layer. However, Knauf discloses a similar method of making a container comprising the step of bonding the liner means to the front panel comprises bonding the liner means to the coating layer and forming at least one cut line in the layer, see for example (Figs. 5 and 11).

The Examiner's reference to Figs. 5 and 11 of Knauf is not understood since the Knauf reference only includes four drawing figures. It is further not clear what relevance, if any, the Knauf reference could possibly have to

S.N. 10/027,744  
Art Unit 3721  
Atty Dkt PP 5.71(c)

applicant's invention. If the Examiner intends to maintain the present rejection, then applicant respectfully requests that the Examiner explain in detail what features disclosed by Knauf are believed to correlate, e.g., to a "liner means", "coating layer" and "cut line" as suggested by the Examiner in the above statement.

S.N. 10/027,744  
Art Unit 3721  
Atty Dkt PP 5.71(c)

**VI. Amendment to the Title**

The title has been amended herein to more closely correlate with the currently active claims (i.e., 20-28) in the application.

In view of the above, all of the claims are now believed to be in condition for allowance. Re-examination and reconsideration are requested.

Respectfully submitted,

KLAAS, LAW, O'MEARA & MALKIN, P.C.

By 

Michael A. Goodwin, Reg. No. 32,697  
KLAAS, LAW, O'MEARA & MALKIN, P.C.  
1999 Broadway, Suite 2225  
Denver, CO 80202  
Telephone: (303) 298-9888  
Fax: (303) 297-2266  
Date: August 19, 2003